

REMARKS

Claims 16-28 and 42-45 were pending in the application. Claim 42 has been cancelled without prejudice and claims 16, 25, 43 and 45 have been amended. Therefore, claims 16-28 and 43-45 are currently pending.

No new matter has been added. Claim 16 has been amended to be directed to a tetracycline compound of formula (III), in which R⁷ is hydrogen, ethyl, phenyl, 4-*t*-butyl, *t*-butylaminomethyl or dimethylamino. Support for the amendments to claim 16 can be found, for example, at least at pages 10-17 of the specification as originally filed. Claim 25 has been amended to correct a grammatical error. Claim 43 has been amended to provide proper dependency. Claim 45 has been amended to correct a grammatical error.

Cancellation and/or amendments to the claims should in no way be construed as an acquiescence to any of the Examiner's objections or rejections. The cancellation and/or amendments to the claims are being made solely to expedite prosecution of the above-identified application. Applicants reserve the option to further prosecute the same or similar claims in the present or another patent application. The amendments made to the claims are not related to any issues of patentability.

Rejection of Claim 16 Under 35 U.S.C. §112, first paragraph

Claim 16 is rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner asserts that "the amendment to claim 16, where R⁷ is other than hydrogen and R^{7a-7d} are new matter."

Applicants respectfully traverse this rejection. However, to expedite prosecution, Applicants have amended claim 16 to be directed to tetracycline compounds of formula (III), in which R⁷ is hydrogen, ethyl, phenyl, 4-*t*-butyl, *t*-butylaminomethyl or dimethylamino. Accordingly, a skilled artisan at the time of the filing of the application would reasonably understand that the inventors had possession of the claimed invention. Therefore, Applicants respectfully request reconsideration and withdrawal of this rejection under 35 U.S.C. §112, first paragraph.

Objection of Claim 26 Under 37 CFR 1.75(c)

Claim 26 is objected to under 37 CFR 1.75(c), as being of improper dependent form. Specifically, the Examiner asserts that "the compounds wherein does not contain aminomethyl moiety at the 9-position does not read on the base claim as now amended."

Applicants respectfully traverse. Claim 26 is an independent claim, and therefore, does not read on claim 16. Accordingly, Applicants respectfully request reconsideration and withdrawal of this objection.

Rejection of Claims 16-24 and 26 Under 35 U.S.C. §102(e)

Claims 16-24 and 26 are rejected under 35 U.S.C. §102(e) as being anticipated by Nelson *et al.* (U.S. Patent No. 6,846,939 supplemented with CA 136:102231).

Applicants respectfully traverse. However, to expedite prosecution, Applicants respectfully submit herewith a Declaration Under 35 U.S.C. §1.132 (Appendix C), which states that Inventors Beena Bhatia, Todd Bowser, Laura Honeyman, Mohamed Y. Ismail, and Mark L. Nelson are the inventors of the substituted tetracycline compounds described in Nelson *et al.* and claimed in the present application. Therefore, the compounds described Nelson *et al.* are not an invention by another as disclosure of the tetracycline compounds in Nelson *et al.* does not qualify as prior art under 35 U.S.C. §102(e).

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of this rejection under 35 U.S.C. §102(e).

Rejection of Claims 16-24 Under 35 U.S.C. §102(e)

Claims 16-24 are rejected under 35 U.S.C. §102(e) as being anticipated by Draper *et al.* (U.S. Patent No. 7,045,507 supplemented with CA 137:244598).

Applicants respectfully traverse. However, to expedite prosecution, Applicants respectfully submit herewith a Declaration under 35 U.S.C. §1.132 (Appendix D), which states that Beena Bhatia, Todd Bowser, Jackson Chen, Laura Honeyman, Mohamed Y. Ismail, Mark L. Nelson, Kwasi Ohemeng, N. Laxma Reddy, Atul Verma, Peter Viski and Ivan Yanachkov are the inventors of the substituted tetracycline compounds described in Draper *et al.* and claimed in the present application.

Applicants respectfully note that signed Declarations from Inventors Kwasi Ohemeng and Peter Viski have not yet been obtained and will be forwarded to the Office upon receipt.

Therefore, the compounds described in Draper *et al.* are not an invention by another as disclosure of the compounds in Draper *et al.* does not qualify as prior art under 35 U.S.C. §102(e).

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of this rejection under 35 U.S.C. §102(e).

Rejection of Claims 16-28 and 42-44 Under 35 U.S.C. §103(a)

Claims 16-28 and 42-44 are rejected under 35 U.S.C. §103(a) as being unpatentable over Nelson *et al.* (U.S. Patent No. 6,846,939) or Draper *et al.* (U.S. Patent No. 7,045,507). Specifically, the Examiner asserts that “the difference between the anticipatory species of the prior art and the species of the instant claims is that the instant claims have an obvious variation of the prior art species by having an alternative chain length, or chain branches...” and that a skilled artisan “in possession of the above references would be motivated to make any compounds generically taught by the prior art.”

35 U.S.C. §103(c)(1) states that

[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of 35 U.S.C. §102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

U.S. Patent No. 6,846,939 and U.S. Patent No. 7,045,507 have been cited by the Examiner as prior art under 35 U.S.C. §102(e), as indicated above. Applicants respectfully submit that the inventions described in U.S. Patent No. 6,846,939, U.S. Patent No. 7,045,507 and the present application were commonly owned at the time the invention in this application was made, as evidenced by copies of the assignments submitted herewith at Appendices A-B, respectively. Therefore, Applicants respectfully request reconsideration and withdrawal of this rejection under 35 U.S.C. §103(a).

Priority of Claims 16-28 and 42-44

The Examiner has asserted that claims 16-28 and 42-44 are directed to the same invention as that of U.S. Patent No. 6,846,939 or U.S. Patent No. 7,045,507. Without acquiescing to the accuracy of the Examiner’s characterization of claims 16-28 and 42-44, Applicants respectfully submit that the inventions described in U.S. Patent No. 6,846,939, U.S. Patent No. 7,045,507 and the present application were commonly owned at the time the invention in this application was made, as described above.

Application No.: 10/737361
Examiner C.C. Chang

Docket No.: PAZ-178CPCN
Group Art Unit: 1625

Objection to Claim 45

Claim 45 is objected to as being dependent upon a rejected base claim. Applicants respectfully submit that this objection is moot based on the amendments to the claims.

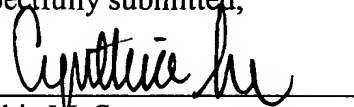
SUMMARY

It is respectfully submitted that this application is in condition for allowance. If there are any remaining issues or the Examiner believes that a telephone conference with Applicants' Attorney would be helpful in expediting prosecution of this application, the Examiner is invited to call the undersigned at (617) 227-7400.

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Respectfully submitted,

By



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